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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,732	06/28/2001	Noboru Iwayama	1405.1045	3572
21171	7590	07/20/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			LE, KHANH H	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. .

09/892,732

Applicant(s)

IWAYAMA ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is responsive to the correspondence dated 5/5/2005. Claims 2,3, and 11 are amended. New claim 12 is added. Claims 1-12 are pending. Claims 1, 2, 9, 10, 11 and 12 are independent.

#### ***Claim Rejections - 35 USC § 112***

2. Previous Rejections of Claims 2-4, 11 under 35 U.S.C. 112, second paragraph are withdrawn following the amendments.

#### ***Interpretation for art application purposes***

3. Claim 3 at page 54 is interpreted as follows: the owners of the ads, registered or not, and their addresses, need to be asked for their permission to correlate ads to content URL's .

Claim 4 : from "said advertising acceptance means... with the unregistered advertising information" , it is interpreted that detailed information is correlated to some ads .

#### ***Response to Arguments***

4. Applicant's arguments have been fully considered but they are not persuasive. In LiQ, certainly the product information sent to the 2<sup>nd</sup> user to view together with the first user is advertising information which includes advertising image data. Further, in LiQ, the second user getting a page (to shop together) implicitly receives a status of the first user, i.e. that the first user is online at the time. Therefore, the LiQ page reads on displaying, on the second computer,

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advertising data image included in said first advertising information broadcast in said broadcast step, as status of the first user (the last step of claim 1).

At page 9 of the amendment, second full paragraph, Applicants point out an example that would read on the last step of claim one: an ad icon entitled "virtual shopping Mall A" displayed to second user (user A) serves to inform user A that user B is online and is visiting a web page relating to the ad material. Thus Applicants agree that the status of the first user, can be implicitly relayed, via an ad icon entitled "virtual shopping Mall A. LiQ is doing the same type of implicit relaying of the first user status by displaying a page for together shopping to the second user. Thus LiQ's page serves as implicitly "displaying a user status".

Further, the arguments at page 10 attacking the combination with Goldhaber are equally unpersuasive, as legally-sufficient motivation to combine the references was presented on page 6 of the last Office Action.

The previous rejections are maintained and the following is a repeat of the last Office Action with minor modifications to address the amended claims and new claim 12. It is further noted that all officially-noted facts, presented earlier, and not seasonally or properly challenged are taken as admitted. MPEP 2144.03.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over LiQ, Inc. Makes Gift-Giving Easier with Online-paging. Shop and Chat Technology lets Consumers make decisions Together , Business Wire, Dec. 21, 1999, herein LiQ-Paging, in view of DIALOG(R)File 640, record # 10719046, BIG BUDDY IS WATCHING YOU San Francisco Chronicle (SF) - SUNDAY, August 6, 2000 By: Cheryl Aimee Barron, herein Barron.**

As to claim 1, 9,10, 12, all steps, (and implicit computer programs/devices), except the step of sending an ad associated with browsing from a first user to a second on-line user as 'status of the first user" such as

- interconnection of the 1<sup>st</sup> and 2<sup>nd</sup> users,
- the 2<sup>nd</sup> user checking on status of 1<sup>st</sup> user,
- a database of ads correlated to some content URL's
- detecting URL's used by the 1<sup>st</sup> user
- extracting ads corresponding to URL's used by 1<sup>st</sup> user

are admitted art (see at least Specifications pages 2-3).

As to sending an ad associated with browsing from a first user to a second on-line user as 'status of the first user", a "status" message is any message.

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LiQ-Paging discloses shopping buddies logged on at LiQ.com are paged privately when their buddies are shopping and invited to join into private chatrooms to see products for together shopping. Thus the 2<sup>nd</sup> user of the LiQ system implicitly gets a message about the status of a first user, about a content being a page viewed by the first user.

Further Barron discloses an instant message system and software where someone notes when a page was viewed by a buddy on line and sends comments. Thus Barron teaches that the 2<sup>nd</sup> user is notified of the particular page viewed by the first user.

It would have been obvious to one skilled in the art at the time the invention was made to add Big Buddy to LiQ-Paging to allow the 2<sup>nd</sup> user to view the page viewed by the first user for together shopping as taught by LiQ-Paging.

Further it is well-known at invention time that many ads are associated with each product/service/information webpage for cross- or up-selling purposes. Therefore it would have been obvious to one skilled in the art at the time the invention was made to send an ad associated with the page viewed to the first user to the second user as well to effect cross- or up-selling to the second user as well.

As to claims 2-4, Official Notice is taken that the following facts are well-known:

accepting ads from advertisers, correlating them to certain content URL's with their permission and communicating with the advertisers (ad owners) using their addresses are obvious and well-known business methods.

Thus it would have been obvious to one skilled in the art at the time the invention was made to add these methods to the system of LiQ-Page/ Barron above effect the system of LiQ-Page/ Barron according to well-accepted business methods.

**6. Claims 5-8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over LiQ-Paging and Barron as applied to claim 4 above, and further in view of Goldhaber et al., US 5,794,210.**

As to claim 5-8,  
the steps of a user requesting detailed information associated with the ad sent, returning the detailed information if available, monitoring access to the ads detailed information from the user, setting awards conditions set for the user based on access to ads, doling out awards as earned, monitoring access counts to detailed ads information, calculating fees to charge advertisers based on the user access are all disclosed either in Goldhaber (see at least abstract, Figs. 1-15 and associated text) or as admitted art in the Specifications (see at least pages 2-3).

It would have been obvious to one skilled in the art at the time the invention was made to add the methods of ad viewing rewards and charging of advertisers taught Goldhaber or admitted, to the advertising system/method of LiQ-Page/ Barron to effect the ad compensation/ charge scheme as taught by Goldhaber or admittedly known, to further encourage ad viewing.

Claim 11 is interpreted as a combination of claims 1-8 wherein the incentives are given to for the 2<sup>nd</sup> (consulting) user. It would have been obvious to one skilled in the art at the time the invention was made , in view of the LiQ-Page/ Barron system of connected sopping together users and in view of Goldhaber's compensation scheme, to add rewarding the consulting user to the LiQ-Page/ Barron system , to encourage ads can be viewing as taught by Goldhaber.

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### Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.



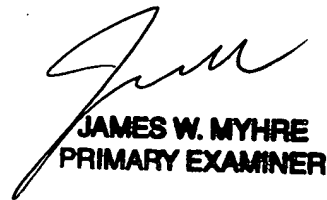
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 18, 2005

KHL

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**JAMES W. MYHRE**  
**PRIMARY EXAMINER**